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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,835	01/11/2001	K. Scott Kammerer	12714	8539
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EXAMINER				
SPISICH, MARK				
ART UNIT			PAPER NUMBER	
1744				
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Donald J. Breh
Illinois Tool Works Inc.
3600 West Lake Avenue
Glenview, IL 60025

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/758,835

Applicant(s)

KAMMERER ET AL.

Examiner

Mark Spisich

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1,2 and 4-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to **make** and/or use the invention. The present application relates to a static-dissipative swab comprising a handle as well as a cleaning tip. The prior art devices (including the prior art described at paragraph 0005 of the present specification) also include a handle as well as a cleaning tip. Applicant's specification (paragraph 0005) also describes that it is known in the art to provide a static-dissipative swab comprising a static-dissipative handle as well as a cleaning tip of polyester. Applicant then makes the assertion that the swab of the present application performs a particular function (in lines 8-13 of claim 1) and that the prior art does not; however, there is NO disclosure of the particular materials which make up the present "swab" which enable it to function as described and which would structurally define over that of the prior art. For example, applicant discloses that the swab of the present applicant may include a cleaning tip formed from polyester (paragraph 0023, line 3), while the admitted prior art also has a static-dissipative handle and a polyester cleaning tip (paragraph 0005) and there is no mention of what is

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different about the swab of the present application relative to that of the prior art (which also includes the prior art made of record by the examiner in the prosecution of this application). If there is a structural difference between the swab of the present application and that of the prior art which constitutes an improvement over the prior art and which enables it to function as described, there is no mention of it.

3. Claims 1,2 and 4-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are indefinite for much the same reason(s) set forth above with respect to the 112, 1st rejection. In addition, claims merely setting forth physical characteristics desired in an article, and not setting forth specific compositions which would meet such characteristics are vague, indefinite and functional. Ex parte Slob (PO BdApp) 157 USPQ 172. This matter is complicated in the present instance in that the materials of the claimed swab which would allegedly be the improvement or the structure which might define over the structure of the prior art are not disclosed with any specificity to define over the structure of the prior art. The addition of "sealed, conductive" to claim 1 (lines 5-6), raises some additional issues with regard to some of the dependent claims. Paragraph 0023 (lines 2-4) states that "the cleaning head portion or cleaning tip can be formed from, for example, foam, conductive foam, micro-porous foam, polyester, **sealed** conductive fabric and wrapped conductive fabric" (emphasis added). The subsequent recitation in claims 4-6 are now incorrect in that, for example, it was not recited that the material was a sealed knit polyester, sealed foam or sealed micro-porous foam.

Comment Re Application of Prior Art

As mentioned in the prior office action(s), the claims have been give their broadest reasonable interpretation.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1,5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pisacane et al (USP 5,460,655) in view of the admitted prior art of paragraph 0005. The patent to Pisacane discloses a swab (40) (see fig 4 as well as column 3, lines 23-30) comprising a handle (of polypropylene) on which is secured an open-cell, hydrophilic, **static-dissipative**, polyurethane foam (see column 3, liens 4-5). The foam material of Pisacane is "heat-sealed" (column 3, lines 25-26) to the handle and is thus "sealed" to the extent required by claim 1. The patent to Pisacane fails to specify wherein the polypropylene handle is "static-dissipative". As admitted in paragraph 0005 of the present application, it is known in the art that a static-dissipative swab be comprised of a static-dissipative handle mounting a static-dissipative tip. As such, it would have been obvious to have modified the swab of Pisacane to further prevent the forming of a static charge on the surface being cleaned. A static-dissipative foam would, to function as such, be "conductive" as in claim 5. With regard to claim 6, one of

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ordinary skill would deem it obvious to utilize dissipative polyurethane foams of any available pore size based on the intended surface to be cleaned.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claim 1 above, and further in view of Ito et al (USP 4,741,066). The patent to Pisacane discloses the use of a polymeric handle and fails only to disclose the specified material of claim 2. The patent to Ito discloses the use of polybutylene terephthalate (column 2, lines 54-56) along with some other constituents and as such is "modified" insofar as this term is defined in the present application. It would have been obvious to one of ordinary skill to have used any such materials recognized in the art as suitable for implement handles based on ease of manufacture, etc.

7. Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claim 1 above, and further in view of Halford et al (USP 4,401,130). The patent to Pisacane discloses a swab in the embodiment of fig 4 and fails only to disclose the foam portion in the form of a seamless tube (essentially the embodiment of fig 3 of the present application). The patent to Halford discloses a cleaning swab wherein the swab material (1) is in the form of a seamless tube which is then bonded or otherwise secured to a handle (2). One of ordinary skill in the art would deem it obvious to utilize any known methods of securing a foam swab to a handle (and which are taught by Halford). With regard to the "tube", one of ordinary skill would deem it obvious to utilize various shapes of the cleaning tip including the tube shape of Halford so that it might be better used to clean tubes.

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8. Claims 1,4 and 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burrow et al (USP 5,214,821) in view of the admitted prior art of paragraph 0005. The patent to Burrow discloses a swab for cleaning electrical equipment in a cleanroom environment comprising a handle (10) of nylon (column 5, line 26) and further including a tubular knit polyester fabric (14) (column 4, lines 9-10) spirally wound onto the handle and thermally **sealed** thereto (the particular manner of thermally attaching the two relates to the method of manufacture and is not germane to the patentability of the device itself). Applicant has defined the cleaning tip as being a knit tube of polyester, which is taught by Burrow. With regard to the material of the handle, applicant's admission in paragraph 0005 states that the used of such a material is known in the art and that it would have been obvious to one of ordinary skill to have modified the device of Burrow so as to reduce or eliminate the creation of static charge (especially given the disclosed use of the device of Burrow in a cleanroom).

Response to Arguments

9. Applicant's arguments filed 9 January 2004 have been fully considered but they are not persuasive. It is first pointed out that the amendment to claim 1 raises a problem with regard to some of the dependent claims. For example, claims 4-6 recite materials which were not recited as being "sealed". The problem with regard to the "112" rejections lies in the specificity with which the cleaning material of the swab is disclosed. The prior art is admitted as comprising a static-dissipative handle with a polyester cleaning head portion (paragraph 0005). The problem arises from the fact that this is essentially same thing described as comprising the present invention

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(paragraph 0023, line 3). Applicant does not describe any modifications made with respect to the polyester material of the admitted prior art and than of the present invention. As the admitted prior art has essentially the same basic components of the present invention, one should not have to resort to guesswork or experimentation as to which type of polyester material produces the desired effect. With regard to the prior art, the examiner applied the prior art against the claims in view of the materials disclosed by the present specification. Both base references disclose a static-dissipative cleaning portion. In order to dissipate static charge, the material would have to be conductive. The use of a conductive material for the handle of the swab is taught by the admitted prior art. The primary issue or concern of the examiner is that the prior art appears from all indications to disclose the basic components of the cleaning swab (a polyester) and it is then claimed that (without describing what is different about the present swab) the present invention works in a certain manner. There is no indication that the prior art has been modified in any manner so as to function as claims. As such, the claims have been rejected under both 112 and 103. On the one hand, the specification appears to disclose a swab which is the same as the prior art and somehow is a great improvement without mentioning what applicant did to modify the swab to cause it to be improved. On the other hand, the prior art (in the 103 rejections) discloses many of the same materials that are said to comprise the present invention. It would be easier to interpret the last paragraph of claim 1 more favorably to applicant if there were some specific working examples which were structurally distinct from the prior art (including that admitted by applicant); however, the examiner (or anyone

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reading the application) reads the present specification and finds the present invention can be practiced by a conductive handle and a polyester cleaning head, which is essentially the prior art. If applicant chose a particular material for the handle and cleaning head or somehow modified the constituent parts of the prior art, such is not disclosed in the present application.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Spisich whose telephone number is (571) 272-1278. The examiner can normally be reached on M-Th (6-3:30), Alternate Fri off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert J Warden can be reached on (571) 272-1281. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Mark Spisich
Primary Examiner
Art Unit 1744

MS